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09/173,445	10/16/1998	BENJAMIN J. KWITEK	KW1-001	1836

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EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 08/20/2003

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 26

Application Number: 09/173,445  
Filing Date: October 16, 1998  
Appellant(s): KWITEK, BENJAMIN J.

\_\_\_\_\_  
Howard N. Flaxman  
For Appellant

**MAILED**  
**AUG 20 2003**  
**GROUP 3700**

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 25 June 2003.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

Art Unit: 3711

**(7) Grouping of Claims**

The rejection of claims 1, 3, 7-10 and 21-29 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

**(8) Claims Appealed**

Claim 14 contain(s) substantial errors as presented in the Appendix to the brief. Accordingly, claim 14 is correctly written in the Appendix to the Examiner's Answer.

**(9) Prior Art of Record**

5,555,584	MOORE	9-1996
5,730,669	HUANG	3-1998

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3, 7-10, 14 and 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang in view of Moore. This rejection is set forth in response by Board of Patent Appeals on request for rehearing dated 16 October 2002, Paper No.21 with the response to the arguments stated in the final rejection stated below.

***Response to Arguments***

The argument that modification of Huang so as to include a thicker gripping surface to read upon the pending claims would be contrary to the teaching of Huang is disagreed with. Huang clearly showed a depth relationship between the lips and a central section as well as a retaining function and it would be obvious to one skilled in the art to utilize different viscoelastic hand surfaces with different thicknesses while still maintaining the depth relationship and retaining function in order to utilize the advantages of the different material. Moore discloses a suitable viscoelastic hand surface material with a suitable thickness which it would be obvious to modify the lips of Huang to maintain the depth relationship and retaining function.

***(11) Response to Argument***

In the arguments filed 25 June 2003, the appellant argues:

1. It is improper to combine the references of Huang with Moore since the combination does not provided for a reasonable likelihood of success.

2. It is improper to combine the references of Huang with Moore since the cited prior art fails to disclose or suggest each of the claimed limitations.

3. It is improper to combine the references of Huang with Moore since nothing in the disclosures of Huang or Moore provides a sufficient basis for rendering obvious a viscoelastic grip with outward extending lips having the defined thickness and depth such to retain the viscoelastic hand surface in position of a shell.

4. It is improper to combine the references of Huang with Moore since Moore does not disclose a need for lips.

5. It is improper to combine the references of Huang with Moore since Huang does not disclose a thickness for lips as those disclosed in the claims. The thickness of the gel material of Moore is substantially thicker than the lips of Huang. Placing the gel material of Moore on the sleeve of Huang would cause an overlap of the lips of Huang and make the grip undesirable as the grip of Moore is currently undesirable due to the lack of support.

6. It is improper to combine the references of Huang with Moore since the lips of Huang do not provide the function of retaining anything.

7. With respect to item 1, the argument that it is improper to combine the references of Huang with Moore since the combination does not provide for a reasonable likelihood of success is disagreed with. Huang discloses a simple arrangement which a sleeve inherently retains an outer layer used for cushioning and

protects it. Clearly an artisan skilled in the art would know that this arrangement would be suitable and provide the same protection to other cushioning material as the resilient material of Moore.

8. With respect to items 2-3 and 5, the arguments that it is improper to combine the references of Huang with Moore since the cited prior art fails to disclose or suggest each of the claimed limitations, since nothing in the disclosures of Huang or Moore provides a sufficient basis for rendering obvious a viscoelastic grip with outward extending lips having the defined thickness and depth such to retain the viscoelastic hand surface in position of a shell and placing the gel material of Moore on the sleeve of Huang would cause an overlap of the lips of Huang and make the grip undesirable as the grip of Moore is currently undesirable due to the lack of support are all disagreed with. Each of the elements of structure are specifically disclosed with the exception of a shell being a soft elastomer and lips having a thickness of between 1/16 and 1/4 inch. The materials for a shell as taught by Huang have similar characteristics as that of a soft elastomer and it is believed that the disclosed materials would suggest to one skilled in the art that a soft elastomer would be a suitable material for a shell. In addition, figures 12-13 show the lips of the shell and the outer layer grip material being flush. Clearly this provides a good appearance and reduced interference with other items in a golf bag both concerns also taught by Huang. An artisan using another suitable type of outer grip material would know also to keep the lips and grip material flush despite the required thickness due to the material used for the same reasons.

Moore discloses a suitable outer material with the claimed thickness. An artisan skilled in the art would know to make the lips also this thickness when using this material in order to provide a good appearance and reduced interference between the outer layer grip material with other items in a golf bag both.

9. With respect to item 4, the argument that it is improper to combine the references of Huang with Moore since Moore does not disclose a need for lips is disagreed with. Just because the grip of Moore does not disclose an element of structure, it does not mean that there is nothing else invented that would not benefit the grip of Moore or not be obvious. This is the whole reason for 35 U.S.C. 103. The question is would a modification be obvious to one skilled in the art. Modifying a grip to have lips retaining an outer surface made of material as disclosed by Moore is believed to be obvious to one skilled in the art due to the teaching of Huang.

10. With respect to item 6, the argument that it is improper to combine the references of Huang with Moore since the lips of Huang do not provide the function of retaining anything is disagreed with. Huang is concerned with a grip having a reduced interference with other items in a bag. Clearly the lips provide reduced interference for the ends of the grip as the recessed side edges provide reduced interference. In addition, the shell of Huang clearly inherently provides a retaining function since the lips provide obstructions from the tape moving in an axial direction along a shaft axis.



11. Finally, the appellant is asking the examiner to reverse the Board of Appeals and the examiner has no authority to do so. However the examiner is in full agreement with the rejection as set out by the Board of Appeals dated 16 October 2002.


For the above reasons, it is believed that the rejections should be sustained.

Application/Control Number: 09/173,445  
Art Unit: 3711

Page 9

Respectfully submitted

Stephen Blau

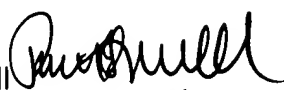
  
STEPHEN BLAU  
PRIMARY EXAMINER

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August 18, 2003

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**APPENDIX**

14. A grip according to claim 9, wherein the tubular shell is a soft elastomer.